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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/606,369 06/28/00 CHEE

M A-67493-3/DJ

EXAMINER
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HM12/0924

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PERSONAL LIST P	
ART UNIT	PAPER NUMBER

1627  
DATE MAILED:

09/24/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

*Restriction Purposes Only*

Application No.  
09/606,369

Applicant(s)  
Stuelpnagel et al

Examiner  
P. Ponnaluri

Art Unit  
1627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-27 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Claims 1-27 are currently pending in this application.

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, a dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Ph.D., Supervisory Patent Examiner at [jyothsna.venkat@uspto.gov](mailto:jyothsna.venkat@uspto.gov) or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

### ***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, drawn to an apparatus comprising a substrate with a surface, classified in class 435, subclass 287.1 or DIG. 43.
  - II. Claims 7-12, drawn to an apparatus comprising more than one substrate, classified in class 435, subclass 287.1 or DIG. 43.
  - III. Claims 13-18, 28, drawn to a hybridization chamber, classified in class 435, subclass 288.4.
  - IV. Claims 19-24, drawn to a method of decoding an array, classified in class 435, subclass 4.

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- V. Claims 25, drawn to a method of determining the presence of one or more target analytes in one or more samples (the samples are contacted with a single substrate), classified in class 435, subclass 4 or class 435, subclass 518.
  - VI. Claim 26, drawn to a method of determining the presence of one or more target analytes in one or more samples (the samples are contacted with more than one substrate), classified in class 435, subclass 4 or class 436, subclass 518.
  - VII. Claim 27, drawn to a method of mixing solutions in an array, classified in class 435, subclass 4.
3. The inventions are distinct, each from the other because of the following reasons: A)A.
- A) Inventions of groups I, II and III are unrelated even though the classification is same. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of group I and II are drawn to different apparatus, which have different parts and the modes of the operation of these apparatus would be different; and the group III apparatus is different from groups I-II apparatus because the hybridization chamber is different and the hybridization chamber can be used along with various other apparatus. The prior art search for these apparatus in the non patenting literature would be different. Thus, restriction between the groups is proper.
- B) Inventions of group V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation,

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different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of group V and VI are different from each other because steps a) and b) of claim 26 are different from claim 25, thus the modes of the operation of the group VI method is different from group V method. Thus, restriction between the groups is proper.

C) Inventions of groups IV and groups V, VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of groups V and VI are different from group IV method. The group IV method does not require the methods of groups V and VI. Thus restriction between the groups is proper.

D) Inventions of group VII and groups IV, V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of group VII are drawn to a different method which has different method steps and the end products would be different from groups VI to VI methods. Thus, restriction between the groups is proper.

E) Inventions of groups I-III and groups IV - VII are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed

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can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the different methods of groups IV-VII do not require the particular apparatus of groups I-III, and the apparatus of groups I-III can be used in different assay methods, i.e., in detection of nucleic acid or drug candidates in combinatorial library.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor ship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. Applicant is required to reply to this restriction requirement within 30 days of mailing this action. See MPEP 809.2(a).

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Any inquiry concerning this communication should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached at (703)308-2439. The fax number for this group is (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.

P. Ponnaluri  
Patent Examiner  
Technology center 1600  
Art Unit 1627  
20 October 2001

  
**PADMASHRI PONNALURI**  
**PRIMARY EXAMINER**

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# RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

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PHONE NUMBER:

TO EXAMINER: **P. Ponnaluri**

ART UNIT: **1627**

SERIAL NUMBER: 09/606,369

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